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09/909,630	07/19/2001	Yakov Kamen	007287.00016	9979
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EXAMINER CASCHERA, ANTONIO A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/909,630

Applicant(s)

KAMEN, YAKOV

Examiner

Antonio A. Caschera

Art Unit

2628

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-17 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-17 and 21-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-883)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Priority

1. This application claims the benefit of application no. 60/241,885, filed 10/19/2000.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 21-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In reference to claim 21 (and all dependent upon claim 21 claims), practices and procedures directed towards the analysis of claim language as per 35 U.S.C. 101 question the antecedent basis for the claimed terminology of a “tangible machine-readable storage medium embodying a sequence of instructions...” as recited in claim 21. The specification of the instant application does not explicitly define the term, “tangible machine-readable storage medium” however it does mention a “computer-readable medium drive” capable of storing instructions for implementing the processing of data as detailed in the claims (see page 8, paragraphs 17-18 of Applicant’s specification). The specification does clearly suggest to one of ordinary skill in the art that such a “tangible machine-readable storage medium” could be one of signals, or other forms of propagation and transmission media (page 8, paragraph 18 of Applicant’s specification) which fail to be an appropriate manufacture under 35 U.S.C. 101 in the context of computer-

related inventions and therefore requires the rejection of claims 21-27. (see *Response to Arguments* below)

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-7, 11-17 and 21-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In reference to claims 1, 11 and 21, new amendments to the claims introduce the language of, "...wherein the non-textual attribute after each modification visually indicates a number of times the object has been selected..." (see for example, step (b) of claim 1). The Examiner believes that such subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention. The specification solely discusses modifying a non-textual attribute of an object corresponding to selection of the object, for example, by making an object darker in color for every consecutive selection of the object (see at least page 6, paragraph 11 of Applicant's specification). Nowhere does the specification discuss "visually indicating the number of times an object is selected". As Applicant has argued the previous prior art, Schein et al. (see page 7,

of Applicant's Remarks of 02/06/09), the Examiner applies such rationale to support this new matter situation. The Examiner states that at best, Applicant's specification provides a manner of corresponding consecutive selection with an object. It is the user of the invention that must infer/deduct the amount of clicks/selections of the object or the user must keep track himself how many times the selection of the object has occurred. The mere fact that the specification provides corresponding color with a consecutive clicks does not "visually indicate the amount of times the object is selected." It solely provides a sort of "gauge" or "range" to the user leaving up the exact amount for questioning or guessing. In other words, making a button darken in color from blue to black does not indicate that I've clicked the button 10 times, for example. Therefore, the Examiner deems the newly amended language of the claims as new matter. Note, claims 2-7, 12-17 and 22-27 depend upon claims 1, 11 and 21 and therefore also suffer from the above issue. Lastly, the Examiner will do its best to apply prior art to the newly amended claim language taking the broadest interpretation of the language of the prior art and the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeong et al. (U.S. Patent 6,256,027) in view of Schein et al. (U.S. Patent 6,075,575).

In reference to claim 1, Jeong et al. discloses a computer implemented method (see column 1, lines 56-60 wherein Jeong et al. discloses a method in a video display apparatus for displaying on-screen display (OSD) menu items.) comprising:

(a) *receiving, at a computing device, a selection of an object displayed in an electronic programming guide (EPG)*

(b) modifying a non-textual attribute associated with the object by an incremental amount for each of at least two times that the *object* is selected, wherein the non-textual attribute after each modification visually indicates a number of times the *object* has been selected, wherein each modification of the attribute includes changing a visible characteristic of the *object* and wherein each modification results in a different appearance of the *object* (see columns 1-2, lines 61-10, column 2, lines 57-66, column 4, lines 6-17, column 5, lines 15-34 and Figures 3A-G wherein Jeong et al. discloses accepting specific key input data signals from a user operating an input device and based upon such input signals, generating OSD menu items with modified data views. Figures 3A-G explicitly show example menu items and their "animations" based upon key inputs. In particular, it can be seen from Figure 3A that a volume OSD menu is generated and modified, increasing and decreasing in bar length towards and away from "min" and "max" levels. The Examiner interprets such graphics of the OSD menu of Jeong et al. to function equivalent to Applicant's claimed language. In particular, it can be seen that the "non-textual" attribute of the data is the length of the "volume bar" which, at least, inherently visually indicates the number of times a user has selected the modification of volume via the closeness of the bar in length to the "min" and "max" indicators. Further, it can be seen that upon each selection of

volume, the "volume bar" inherently changes in length (via an incremental amount) resulting in a different appearance of the bar.); and

(c) modifying the display of the *object* in accordance with the modified non-textual attribute (see column 5, lines 15-34 and Figures 3A-G wherein these figures explicitly show example menu items and their "animations" based upon key inputs. In particular, it can be seen from Figure 3A that a volume OSD menu is generated and modified, increasing and decreasing in bar length towards and away from "min" and "max" levels.).

Although Jeong et al. does disclose modifying a non-textual attribute of an object however Jeong et al. does the explicitly disclose selection of the actual object in an EPG. Schein et al. discloses a system and method for controlling information on a visual interface of a television screen (see column 1, lines 61-67). Schein et al. discloses the GUI to consist of an EPG controlled via a remote control which further contains volume buttons (see Figures 1 and 4). Schein et al. further discloses selecting an item/object in the EPG using the remote control (see column 8, lines 37-61 and columns 8-9, lines 62-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the selecting of objects in the EPG of Schein et al. with the OSD attribute modification techniques of Jeong et al. in order to provide the user with the best amount of information for controlling the system based upon user input by supplying visual feedback of key presses of user input devices.

In reference to claim 11, claim 11 is equivalent in scope to claim 1 and is therefore rejected under similar rationale. In addition to the rationale applied to claim 11, claim 11 recites an apparatus comprising a processor and memory configured to store computer readable instructions that when executed, cause the processor to perform the steps as recited. At least

Schein et al. discloses the invention to comprise of a system for use with the remote control, the system made up of a computer which further comprises a processor and memory (i.e. hard drive and disk input) that embodies a computer program providing the software needed for receiving, organizing and displaying data for the television program guide (see columns 6-7, lines 60-41 and Figure 3).

In reference to claim 21, claim 21 is equivalent in scope to claim 1 and is therefore rejected under similar rationale. In addition to the rationale applied to claim 21, claim 21 recites a physical machine-readable storage medium embodying a sequence of instructions executable by a machine to perform a method as recited. At least Schein et al. discloses the invention to comprise of a system for use with the remote control, the system made up of a computer which further comprises a processor and memory (i.e. hard drive and disk input) that embodies a computer program providing the software needed for receiving, organizing and displaying data for the television program guide (see columns 6-7, lines 60-41 and Figure 3).

Response to Arguments

5. Applicant's arguments, see page 6 of Applicant's Remarks, filed 02/06/09, with respect to the 35 USC 101 rejection of claims 1-7 have been fully considered and are persuasive. The 35 USC 101 rejection of claims 1-7 has been withdrawn since amendments to the claims now tie at least the "receiving" step of the claim to a computer device, which accomplishes the claimed method step.
6. Applicant's arguments, see page 7 of Applicant's Remarks, filed 02/06/09, with respect to the rejection(s) of claim(s) 1, 11 and 21 under 35 USC 103(a) in view of Schein et al. have

been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Jeong et al. and Schein et al..

7. Applicant's arguments filed 02/06/09 have been fully considered but they are not persuasive.

In reference to claims 21-27, Applicant argues the 35 USC 101 rejection of claims 21-27 such that Applicant believes the term "tangible machine-readable storage medium" satisfies 35 USC 101 (see pages 6-7 of Applicant's Remarks).

In response, the Examiner states, it is because the specification offers the possibility of any type of medium being of non-statutory (i.e. one that carries waves, propagation signals etc) type that the claims still remain rejected under 35 USC 101. The Examiner further states that according to the current practices of Technology Center 2600, at this time the Examiner cannot positively accept the term "tangible" as not referring to a signal or carrier wave. Therefore, the claims can still be interpreted as reciting non-statutory subject matter and are rejected under 35 USC 101 as seen above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Antonio Caschera whose telephone number is (571) 272-7781. The examiner can normally be reached Monday-Friday between 7:00 AM and 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung, can be reached at (571) 272-7794.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

571-273-8300 (Central Fax)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (571) 272-2600.

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/Antonio A Caschera/

Primary Examiner, Art Unit 2628

4/21/09